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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,381	07/18/2003	Lex P. Jansen	03-118 (US01)	3194

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EXAMINER

WILLSE, DAVID H

ART UNIT PAPER NUMBER

3738

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/623,381

Applicant(s)

JANSEN ET AL.

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on May 17, 2004, is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10-6-03; 10-29-04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

The abstract of the disclosure is objected to because on line 8, "contacts point" should apparently read --contact points--. Correction is required (MPEP § 608.01(b)).

The disclosure is objected to because of the following informalities: On page 4, line 7, --a-- should be inserted after "comprise"; on line 19, "comprises" should be replaced by --comprise--. In Figure 10, "108" should apparently be --112-- in view of the discussion at page 13, lines 3-6. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 5, line 2, "the web-like arrangement" lacks a proper antecedent basis.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 4-6, 20-22, 28, and 29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hanslik et al., DE 29 10 627 A1: Derwent abstract and Figure 3. The implantable network comprises at least one laterally resilient wire composed “of metals, metal alloys, ceramics, carbon and/or synthetics” (Derwent abstract, lines 4-5). In one embodiment (Figure 3), the network of wires is configured to be introduced into a cavity of a vertebral body. [Each of the threads or wires also meets the limitations of claims 1 and 2 both prior to and after being joined by welds or the like.] Regarding claim 4, the threads or wires are “individual” (line 1) at least prior to being welded together.

Claims 3, 23, 27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanslik et al., DE 29 10 627 A1. Regarding claims 3 and 23, PMMA would have been an obvious synthetic material because of its wide usage in bone repair and because of its advantageous mechanical properties and biocompatibility. Regarding claim 27, a bone growth inducing material would have been obvious to the ordinary practitioner at the time of the present invention because it is now common practice to facilitate osseointegration with such devices.

Regarding claim 30, a compression fracture reducing device would have been obvious in order to enable the insertion of the implant into a cavity of the vertebra.

Claims 1, 4, 20, 22, and 27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Renvert, WO 98/35628 A1, which discloses a bone implant comprising an elongate, laterally resilient wire of a biocompatible material (abstract; page 3, lines 11-20; page 4, lines 3-10), the wire being configured to be introduced into a cavity of a bone structure (page 4, lines 25-32). Regarding claim 27: page 4, lines 22-24; page 6, lines 21-23. Regarding claim 22: page 4, lines 6-10.

Claims 1, 4, 5, 20, 22, 24, 25, and 27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Comfort, US 6,143,036. Regarding claim 5: Figure 4; column 6, lines 37-38 and 46-47. Regarding claim 24: column 5, line 66, to column 6, line 2. Regarding claim 25, attention is directed to MPEP § 2113.

Claims 2, 6, 26, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comfort, US 6,143,036. Regarding claim 2 and others, the bone augmentation device being used to treat vertebral compression fractures would have been obvious to the ordinary practitioner in view of column 6, lines 35-53, because such a problem is often encountered. Regarding claim 26, the wires and the uncured bone cement being of PMMA would have been an obvious variant on the disclosed coatings or materials and the fibrin glue in order to improve the initial securement and in order to utilize the advantageous properties of PMMA. Regarding claim 30, a separate compression fracture reducing device would have been obvious for reasons cited above.

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Claims 1, 2, 4-8, 17, 18, 20, 21, 24, 25, 28, and 29 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Thomas et al., US 2003/0074075 A1. Regarding claim 2 and others: paragraphs **0007** and **0116**. Regarding claim 7 and others: Figures 11a and 29d; paragraphs **0083**, **0090**, and **0106** through **0112**. Regarding claim 24 and others: paragraph **0118**.

Claims 3, 9-16, 19, 22, 23, 26, 27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al., US 2003/0074075 A1. Regarding claim 3 and others, the wire being at least partially of PMMA would have been obvious in order to enhance bonding with the PMMA bone cement (paragraph **0118**) or to impart alternative properties to the implant. Regarding claims 11 and 12, the inherent bone cement applying device being insertable through one of the outer tubes or cannulae described by Thomas et al. would have been obvious in order to maintain the minimal incision required. Regarding claim 15, a plunger assembly would likewise have been obvious in order to inject bone graft "for more successful healing" (paragraph **0118**). Regarding claim 19, a compression fracture reducing device would have been obvious in order to gain access to the bone defect to be filled.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762 and who is generally available Monday through Thursday and sometimes on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



**Dave Willse**  
**Primary Examiner**  
**Art Unit 3738**